

Appl. No. 10/623,899
Amdt. dated July 11, 2005
Reply to Office Action of March 9, 2005

PATENT

REMARKS/ARGUMENTS

Claims 1-20 remain pending in the application, and Applicant respectfully requests reconsideration and allowance of the claims.

Discussion of Objections to the Specification

The abstract of the disclosure was objected to for inclusion of the term "means" in describing the add value terminal. Applicant amends the abstract to replace the term "means" with similar language. A clean copy of the abstract on a separate sheet is provided as an attachment to this paper.

Discussion of Objections to the Specification

Claim 10 was objected to for a typographic error appearing in the punctuation. Applicant amends claim 10 in the manner suggested by the Examiner. Applicant respectfully believes the amendment overcomes the objections to the claims.

Discussion of Claim Rejections Under Obviousness Type Double Patenting

Claims 1 and 10 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claim 1 of U.S. Patent No. 6,595,416 to Newsome et al. (hereinafter Newsome). Applicant respectfully traverses the rejection and requests reconsideration and withdrawal of the rejection.

Claim 1 of the present application includes "a control and memory assembly." Unlike the control and memory assembly of claim 1 from the Newsome patent, Applicant's claim 1 explicitly recites various features of the control and memory assembly. In particular, claim 1 of the present application recites a control and memory assembly that comprises "means for storing a history of the at least one cashless transaction." Additionally, claim 1 from the present application does not require that the "control and memory assembly [be] connected to the transit station controller through serial communication links" as required in claim 1 of Newsome.

Therefore, Applicant believes that claim 1 of the present application differs from claim 1 of Newsome by more than the language identified by the Examiner. The present claim 1 is not generic to claim 1 from Newsome, because claim 1 from the application includes features

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not recited in Newsome claim 1. Thus, claim 1 from the present application and claim 1 from Newsome cannot be classified as genus and species, as argued by the Examiner.

The Examiner provides no indication that the differences identified above by the Applicant are obvious. The Examiner provides no suggestion or motivation to modify the invention claimed in claim 1 of Newsome in a manner that would provide claim 1 of the present application. Therefore, Applicant believes that the Examiner fails to establish a *prima facie* case of obviousness in light of claim 1 from Newsome. Applicant respectfully requests reconsideration and allowance of claim 1. Applicant also requests reconsideration and allowance of claim 10, because claim 10 depends from claim 1.

Discussion of Rejections Under 35 USC §103(a)

Claims 1, and 10-11 were rejected under 35 USC §103(a) as allegedly unpatentable over Japanese Publication JP 09-305806 to Kiribuchi (hereinafter Kiribuchi) in view of U.S. Patent No. 4,977,502 to Baker et al. (hereinafter Baker). Claims 2, 4 12-13, 15, and 17-19 were rejected as allegedly unpatentable over Kiribuchi in view of Baker, and further in view of Japanese Publication JP 05-028335 to Aoyanagi et al. (hereinafter Aoyanagi). Claims 3, 5, 6, and 14 were rejected as allegedly unpatentable over Kiribuchi in view of Baker, and further in view of U.S. Patent No. 6,003,776 to Drupsteen (hereinafter Drupsteen). Claims 7, 8, and 16 were rejected as allegedly unpatentable over Kiribuchi in view of Baker, and further in view of U.S. Patent No. 5,255,182 to Adams (hereinafter Adams). Claims 9 and 20 were rejected as allegedly unpatentable over Kiribuchi in view of Baker, and further in view of U.S. Patent Application Publication No. 2001/0056412 to Kutsuzawa et al. (hereinafter Kutsuzawa). The Examiner contends that the combination of references describes the claimed inventions.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach or suggest all of the claim limitations.

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The combination of Kiribuchi and Baker fails to teach or suggest all limitations of claim 1. The Examiner concedes that Kiribuchi fails to teach or suggest a means for storing a history of the at least one cashless transaction. However, the Examiner contends that Baker teaches a microprocessor in a magnetic fare card system that records payment of a fare and the amount of the fare.

The Examiner contends that it would be obvious to modify the teachings of Kiribuchi to incorporate the teachings of Baker in order to provide Kiribuchi with the capability of transaction verification. However, one of ordinary skill in the art would not be motivated as described by the Examiner because Kiribuchi already provides a printed receipt to the customer upon completion of the transaction. "[T]he credit slip is printed at a credit slip printing part 27 and issued from a change return port 13 as a slip for user duplicate."

Therefore, because Kiribuchi already provides for a printed receipt issued to the user as verification of the transaction, one would not be motivated to include a means for storing a history of a cashless transaction. Additionally, because Kiribuchi describes payment with a credit card, the credit card issuer would necessarily include a record of the transaction in order to bill the user. Thus, the user would already have a separate independent method of verifying the transaction. There is no indication that these methods of verification are insufficient, or that having a means for storing a history of a cashless transaction would somehow be needed or even advantageous compared to the verification methods already disclosed and available. Thus, there is no motivation to modify the Kiribuchi in the manner suggested by the Examiner.

Therefore, Applicant respectfully requests reconsideration and allowance of claim 1. Claim 12 includes a similar feature of "the control and memory assembly for storing a history of the cashless transaction." Thus, Claim 12 is believed to be allowable for the same reasons provided with respect to claim 1.

Claims 2-11 and 13-16 depend from one of claims 1 or 12 and are believed to be allowable at least for the reasons that the claims depend from an allowable base claim. The Examiner does not allege that any of the other references cited in combination with Kiribuchi and Baker describe or otherwise suggest "storing a history of the cashless transaction." Applicant respectfully requests reconsideration and allowance of claims 2-11 and 13-16.

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Claims 17 was rejected as allegedly unpatentable over Kiribuchi in view of Baker, and further in view of Aoyanagi. Claim 17 includes "providing a terminal in communication with a transit station controller for adding value to the plurality of fare cards utilizing credit and debit accounts only" and "communicating with the transit station controller for authorizing a transaction value of the plurality of transaction values." These features are not taught nor suggested by any of the references, either alone or in combination.

None of the cited references teaches or suggests a terminal in communication with a transit station controller. Indeed, because Baker describes a bus farebox, there is no description of communicating with the transit station controller in order to authorize a transaction value. The bus farebox does not have the ability to communicate to the transit station controller when installed in the bus. Additionally, neither Kiribuchi nor Aoyanagi describes a connection to a transit station controller. Therefore neither Kiribuchi nor Aoyanagi describe or suggest "communicating with the transit station controller for authorizing a transaction value of the plurality of transaction values."

Applicant respectfully request reconsideration and allowance of claim 17 because the cited references, either alone or in combination, fails to teach or suggest all limitations of the claim. Claims 18-20 depend from claim 17 and are believed to be allowable at least for the reason that they depend from an allowable base claim.

With respect to claims 9 and 20, none of the cited references describes a special status fare card. The special status fare card is described in Applicant's specification to include "pre-authorization to add value to the card though an existing line of credit." Specification, page 17, paragraph [0053], ll. 29-32. Kutsuzawa does not describe such a card as alleged by the Examiner. Thus, claims 9 and 20 are believed to be allowable for the independent reason that the cited references fail to describe the additional feature of a special status fare card. Applicant requests reconsideration and allowance of claims 9 and 20 for the reasons provided independent of any other reasons provided.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



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Amendments to the Abstract:

Please replace the Abstract with the following:

An add value terminal provides an automatic fare collection environment with a compact, easy to use, and easy to install device that re-values and issues transit fare smart cards exclusively utilizing credit and debit functions. The add value terminal alleviates long lines often associated with automatic vending machines that allow bill and coin transactions. The add value terminal also ~~provides a means~~ can be configured to sell tickets in out-of-station environments including malls, grocery stores, post offices, and airports.